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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,649	08/01/2001	Hiroshiye Yabe	4035-0144P	2640

2292 7590 10/04/2004

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

NASH, LASHANYA RENEE

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/918,649

Applicant(s)

YABE, HIROSHIYE

Examiner

LaShanya R Nash

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1- 15 are pending.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

The abstract of the disclosure is objected to because of the use of legal phraseology, specifically the term "said" on lines 3,11, and 13. Correction is required. See MPEP § 608.01(b). Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The

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disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.

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- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Examiner suggest replacing section headings TECHNICAL BACKGROUND (page 1), DISCLOSURE OF THE INVENTION (page 2), and PREFERRED EMBODIMENTS (page 4) of this application with the aforementioned section headings (e), (f), and (h) respectively.

Claim Objections

Claim 1 is objected to because of the following informality: grammatical error.

Examiner suggests replacing "Individually delivering system" on line 1 of the claim with "An individually delivering system" for proper correction.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,5-8, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1,6, and 14 are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Examiner suggests amending these aforementioned claims for proper correction. For the purposes of prior art rejection, the broadest reasonable interpretation of the claim language has been applied.

The terms "approximately" and "several" in claim 5 are relative terms which render the claim indefinite. The aforementioned terms are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For the purposes of prior art rejections, the terms have been interpreted by the examiner as "at least" and "more than one", respectively.

The term "substantially" in claims 7 and 8 is a relative term which renders the claims indefinite. The aforementioned term is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For the purposes of prior art rejections, the terms have been interpreted by the examiner as "at least".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Segur et al. (US Patent 6,212,550), hereinafter referred to as Segur.

In reference to claim 1, Segur discloses a system for delivering stored messages in a plurality of communication formats to a specified recipient, in order reduce the number of potential messaging sources (column 1, lines 58-65; column 4, lines 10-15; and Figure 2). Segur discloses :

- An individually delivering system in which a terminal (i.e. message receiving device) of each recipient is connected to a host computer (i.e. client-server) via a wireless or wired telecommunications network, (column 2, lines 10-45; column 2, lines 53-55; and Figure 2);
- A recipient identifying device (i.e. client-server) adapted to identify a recipient on the basis of the recipient's personal data at least including the recipient's mail

address (i.e. email address) and name (i.e. customer id), (column 3, lines 2-23; column 2, lines 56-60; and Figure 4);

- A name exchanging device (i.e. client-server) adapted to exchange the recipient's name for a temporary name (i.e. one of a plurality of addresses) accompanying text or graphic matter previously stored in a recorder (i.e. memory), (column 3, lines 5-17 and Figure 5); and
- A delivery device (i.e. client-server) adapted for individually delivering the text or the graphic matter into which the recipient's name has been introduced by the name exchanging device to the recipient's mail address at a time or times predetermined by the recipient identifying device, (column 3, lines 27-34; column 3, line 52-65; column 4, lines 3-9; column 2, lines 6-8; and Figure 6).

In reference to claim 2, Segur discloses the multi-format messaging system wherein the text delivered by the delivery device (i.e. client-server) to the mail address (i.e. email address) of the recipient comprises voice data, (column 1, line 65 to column 2, line 6 and column 2, lines 62-65).

In reference to claim 3, Segur discloses the multi-format messaging system wherein the text delivered by the delivery device (i.e. client-server) to the mail address (i.e. mail address) of the recipient comprises moving image (i.e. video mail messages), (column 1, line 65 to column 2, line 6).

In reference to claim 14, Segur discloses the multi-format messaging system wherein the name exchanging device (i.e. client-server) is operatively associated with the recipient identifying device so that the text or the graphic matter is different for every recipient and for every delivery, (column 3, lines 25-34).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4,9-10, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segur as applied to the claims above, and further in view of Balma et al. (US Patent 6,157,945), herein after referred to as Balma.

In reference to claim 4, Segur discloses substantial features of the claimed invention as previously evidenced, particularly identifying the intended recipient (column 3, lines 27-34). However, the reference fails to disclose the recipient identifying device recording a time at which the recipient's personal data was received together with the personal data and identifies the recipient. Nonetheless, this modification to the aforementioned system would have been obvious to a person of ordinary skill in the art at the time of the invention, as further evidenced by Balma.

In an analogous art, Balma discloses a system for routing or forwarding electronic messages to an intended recipient according to stored personal data (i.e.

profile) defined by the recipient. Balma further discloses the user profile contains an associated date/time field for the received personal data (column 7, lines 54-58; column 8, lines 41-49; and Figure 5). This modification would have been obvious to the multi-format message system as disclosed by Segur because one of ordinary skill in the art would have been motivated to extend the functionality of the system for automatic delivery of messages based on temporal information, thereby increasing the ease of use (Balma column 2, lines 1-6).

In reference to claim 9, Segur and Balma disclose a multi-format messaging system wherein the recipient's personal data (i.e. profile) includes attributes of this recipient and memorial days (i.e. holidays) peculiar to this recipient, (Balma column 7, line 54 to column 8, line 60; column 9, lines 29-46; Figure 5; and Figure 6-item 304).

In reference to claim 10, Segur and Balma disclose a multi-format messaging system wherein the text accompanied with the temporary name (i.e. address) is a liaison matter for business (i.e. corporate communications) , (Segur column 3, lines 27-34; Balma column 7, line 58 to column 8, line 10; and column 2, lines 25-40).

In reference to claim 15, Segur and Balma disclose a multi-format messaging system wherein the recipient's personal data (i.e. profile) includes date and hour (i.e. scheduling information) in which text and graphic matter should be received by the

recipient so that the delivery device may operate on that date and hour (Balma column 9, lines 29-46; column 9, lines 61-64; and Figure 6-item 304).

Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segur as applied to the claims above, and further in view of Balma et. al (US Patent 6,157,945) and Reynolds et al. (US Patent 6,052,717), herein after referred to as Balma and Reynolds respectively.

In reference to claim 5, Segur and Balma disclose a multi-format messaging system wherein the text is accompanied with a temporary name (i.e. address), (Segur column 3, lines 27-34). However, the reference fails to disclose the aforementioned text comprises a serial novel including at least ten chapters, each comprising at least one hundred characters that are successively delivered starting from its chapter one to the recipient once for every day. Nonetheless, one of ordinary skill in the art would have readily recognized at the time of the invention the advantages associated with implementing these limitations in the multi-format system, as further evidenced by Balma and Reynolds.

In an analogous art, Balma discloses a system for routing or forwarding electronic messages to an intended recipient according to stored personal data (i.e. profile) defined by the recipient. In addition, Balma discloses routine scheduling for routing communications to a recipient, specifically forwarding on a daily basis (Balma column 9, line 29-46). This modification would have been obvious to the multi-format message system as disclosed by Segur because one of ordinary skill in the art would

have been motivated to extend the functionality of the system for automatic delivery of messages based on temporal information, thereby increasing the ease of use (Balma column 2, lines 1-6).

In another analogous art, Reynolds discloses an interactive web book (ibook) system that allows users to view the contents of an interactive book (i.e. novel) that resides on a data network, (i.e. Internet), (column 1, lines 24-38, and column 3, lines 3-16). Reynolds also discloses interactive books to contain several chapters and characters, (column 3, lines 50-57; column 7, line 65 to column 8, line 11; and Figure 7). Reynolds further discloses that the interactive web book system comprises a navigation tool, which allows viewers to automatically view chapters in a book sequentially, (column 10, line 64 to column 11, line 6). In addition, the navigation tool is disclosed to store information about ibook access requests for each client, such as corresponding date and time (column 11, lines 24-60). Therefore, it would have been obvious to incorporate the interactive book access information into the routine scheduling profile (Balma column 9, line 29-46) for implementation of the claimed limitations. One of ordinary skill in the art at the time of the invention would have been so motivated to implement these modifications so as to extend the functionality of the multi-format message system to provide literary and artistic material (e.g. essays, songs, paintings) for user enjoyment, (Reynolds column 3, lines 3-4).

In reference to claim 6, Segur, Balma, and Reynolds show the multi-format messaging system wherein each chapter of the serial novel (i.e. interactive book) is

added with choices (i.e. derivation links) when the chapter is delivered (i.e. accessed) so that the recipient may select a development (i.e. derivation) of the novel and the content of the following subsequent chapter may be adjusted depending on the development selected by the recipient, (Reynolds column 7, lines 8-22; column 8, line 61 to column 9, line 26; and Figure 7).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Segur as applied to the claims above, and further in view of Balma et. al (US Patent 6,157,945) and presto_print.com (Google Newsgroup retrieved from Internet), hereinafter referred to as Balma and presto_print.com respectively.

In reference to claim 7, Segur, Balma, and Reynolds teach a multi-format messaging system wherein text is accompanied with the temporary name stored in the recorder (i.e. memory), (Segur column 3, lines 27-34 and Reynolds column 3, lines 3-16). However, the references do not teach expressly the text comprising a metrical composition completed in every delivery and composed of sentences containing respective characters constituting the temporary name and wherein the metrical composition is delivered to the recipient at least once a month. Nonetheless, acrostic metrical compositions were well known in the art at the time of the invention, as further evidenced by presto_print.com. As a result, these modifications would have been obvious to one of ordinary skill in the art at the time of the invention.

In an analogous art, Balma discloses a system for routing or forwarding electronic messages to an intended recipient according to stored personal data (i.e.

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profile) defined by the recipient. In addition, Balma discloses routine scheduling for routing communications to a recipient, specifically forwarding messages at least once a month (Balma column 9, line 29-46). This modification would have been obvious to the multi-format message system as disclosed by Segur because one of ordinary skill in the art would have been motivated to extend the functionality of the system for automatic delivery of messages based on temporal information, thereby increasing the ease of use (Balma column 2, lines 1-6).

presto_print.com teaches that acrostic name poems use a designated name in order to create metrical compositions (i.e. poetry). One of ordinary skill in the art would have been motivated to automatically deliver acrostics to recipients within the multi-format message system, in order to increase message personalization.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Segur and Balma as applied to the claims above, and further in view of Hayes-Roth (US Patent Application Publication 2002/0054072), herein after referred to as Hayes-Roth.

In reference to claim 8, Segur and Balma teach a multi-format messaging system wherein the matter accompanied with the temporary name stored in the recorder (i.e. memory) is of multiple formats (Segur column 3, lines 27-34; column 1, line 65 to column 2, line 10) However, the references do not expressly teach graphic matter accompanying the temporary name contains the temporary name as components of the graphic matter and is delivered to the recipient at least once for every month.

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Nevertheless, this modification to the multi-format message system would have been obvious to one of ordinary skill in the art at the time of the invention, as further evidenced by Hayes-Roth.

In an analogous art, Balma discloses a system for routing or forwarding electronic messages to an intended recipient according to stored personal data (i.e. profile) defined by the recipient. In addition, Balma discloses routine scheduling for routing communications to a recipient, specifically forwarding messages at least once a month (Balma column 9, line 29-46). This modification would have been obvious to the multi-format message system as disclosed by Segur because one of ordinary skill in the art would have been motivated to extend the functionality of the system for automatic delivery of messages based on temporal information, thereby increasing the ease of use (Balma column 2, lines 1-6).

In another analogous art, Hayes-Roth discloses an interactive messenger system that employs an animated graphic (paragraph [0024], line 5 to paragraph [0025], line 25). This graphic is further disclosed to contain a specified temporary name (i.e. recipient name) as a component (Figures 1-3). This modification would have been obvious because one of ordinary skill in the art would have been motivated to make use of interactive agent technology to enable senders to dispatch interactive messengers to initiate or solicit personalized interactions, thereby increasing system personalization for users (Hayes-Roth paragraph [0008], lines 1-6).

Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segur as applied to the claims above, and further in view of Blue Mountain (Blue Mountain Arts' Electronic Greeting Cards retrieved from the Internet), hereinafter referred to as Blue Mountain.

In reference to claims 11-13, Segur discloses a multi-format messaging system wherein text accompanies the temporary name (Segur column 3, lines 27-34). However, the reference does not disclose expressly that the aforementioned text: comprises educational materials edited in accordance with a predetermined program [claim 11]; has a psychological content for encouragement [claim 12]; and has a formal content for congratulations or condolence [claim 13]. Nonetheless, these limitations would have been obvious modifications to the system disclosed by Segur, as further evidenced by Blue Mountain.


In an analogous art, Blue mountain discloses electronic greeting cards that contain text to send to an intended recipient that is associated with the categories: educational material (i.e. graduation); psychological content for encouragement (i.e. follow dreams or inspiration); and formal content for congratulations or condolence (i.e. congratulations or sympathy). One of ordinary skill in the art would have been motivated to accordingly modify the multi-format system, so as to personalize and transmit electronic text messages containing content from a plurality of literary genres, thereby increasing system versatility.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaShanya R Nash whose telephone number is (703) 305-8910. The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (703) 305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


GLENTON B. BURGESS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100